

Response
Serial No. 10/670,571
Attorney Docket No. 031162

REMARKS

Claims 1-7 are pending in the present application.

Applicants' Response to Claim Rejections under 35 U.S.C. §102

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as being anticipated by Matsumoto et al. (U.S. Patent No. 5,815,060).

As in the previous Office Action, it is the position of the pending Office Action that Matsumoto discloses the invention as claimed. In response to Applicants' previous argument that the magnetic core 2 of Matsumoto is formed directly on the lead line 4, thus resulting in a lack of a clearance, the Office Action states the following:

The examiner disagrees. Matsumoto discloses magnetic core [2, 3] wound around the lead line [4], during the winding process, a small gap or clearance would exhibit between the magnetic core and the lead line. Applicant do not define how big of the clearance between the lead line and the magnetic core. April 6, 2006 Office Action, page 3.

Thus, the Office Action again argues that Matsumoto discloses a gap or clearance inherently. It appears that it is the position of the Office Action that a very small gap or clearance is present in Matsumoto.

The Office Action argues that "Matsumoto et al. inherently discloses a clearance between the hollow part of the magnetic core and the lead." However, according to MPEP § 2112:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (emphasis in original).

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In other words, in order to rely on the inherency argument, it must be shown that a clearance is necessarily present in Matsumoto.

Matsumoto does not disclose a clearance between the hollow part of the magnetic core 2 and the lead line 4. Matsumoto discloses an inductance element 1 comprising a lead line 4 and a magnetic core 2, which is made of a wound-up thin strip 3. Figures 1-3 disclose an embodiment where the magnetic core 2 is disposed directly on the lead line 4. Figure 4 discloses a plurality of inductance elements disposed in an epoxy resin 5 forming a package body.

It is noted that Figure 7 discloses the formation of inductance element 1 by wrapping a thin strip 3 around a lead line 4 to form a magnetic core 2. The magnetic core 2 is disposed directly on the lead line 4. In fact, Example 1, which corresponds to Figure 7, discloses a lead line 4 having a diameter of 1.6 mm, and “an element 1 having an inner diameter of 1.6 mm.” See Column 9, lines 22-24. Thus, the disclosure of Example 1 does not contain a gap or clearance.

It is noted that Matsumoto also discloses an embodiment where the magnetic core 2 is formed by winding thin strip 3 around an unpictured core member. The core member is then removed, resulting in a hollow magnetic core 2. The lead line 4 is then inserted in the magnetic core 2. See column 7, line 61 to column 8, line 9. This embodiment is not discussed in the Examples, and the specific dimensions are not disclosed. However, it is noted that no gap or clearance is disclosed or suggested. Since this embodiment fully supports a construction wherein the lead line 4 and the inner diameter of the magnetic core 2 are identical, a clearance is not necessary present.

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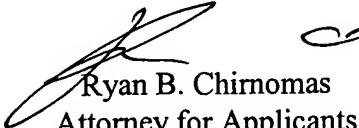
Therefore, for at least the reasons discussed above, Applicants respectfully submit that Matsumoto does not necessarily disclose a clearance between the magnetic core 2 and the lead line 4. Matsumoto discloses the opposite: a magnetic core 2 “directly wound” on lead line 4. See Figure 7 and associated text. In fact, Example 1 shows an embodiment wherein magnetic core 2 and lead line 4 are of the same diameter, thus having no clearance or gap by definition. Therefore, Applicants respectfully traverse the rejection. Favorable reconsideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants’ undersigned agent.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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